

### **REMARKS**

Claims 1, 2, 4, 12 and 13 have been cancelled.

Claims 3 and 5 have been amended.

Claims 12 and 13 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention.

These claims have been cancelled so this rejection is made moot.

Claims 12 and 13 are rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. These claims do not fall within an enumerated statutory category; do not cover a 101 judicial exception or a practical application. Thereof, as required in the Interim guidelines for Examination published in the OG of November 22, 2005. These claims recite only nonfunctional descriptive material and therefore are nonstatutory.

These claims have been cancelled so this rejection is made moot.

Claims 1, 3, 4, 6-9, 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilman et al. (US Pat. No. 6,208,770) in view of Koyata et al. et al. (US Pat. No. 6,462,753).

Amended claim 3 is the only independent claim remaining in this case. It includes the important feature of transferring digital image files onto a removable storage medium that is provided with audio and printing enabling software. The audio enabling software is used to provide audio information onto the removable storage medium that already has the digital files representing colored digital images.

Gilman et al. do disclose a method of providing printing enabling software and images on a removable storage medium. Gilman et al. have nothing to do with recording audio or having audio enabling software on a removable storage medium. There is nothing in Gilman et al. that would suggest the advantages of being able to transfer audio information onto a removable storage medium having digital image files by using audio enabling software already provided on the removable storage medium. Gilman et al.'s teachings are restricted to images and printing such images. Gilman et al. provides no mention or suggestion of providing audio information by using audio enabling software formed on a removable storage medium.

The Examiner has cited Koyata et al. and says that Koyata et al. discloses recording audio on a removable software medium having audio enabling software. Applicants believe that this is an incorrect interpretation of Koyata et al. Koyata et al. disclose a reproducing apparatus in a dubbing system wherein audio information is transferred from one medium to another. Applicants do not believe that the audio enabling software is found on any medium. Still further, no images are involved in this dubbing system. Applicants do not understand how Koyata et al. can reasonably be combined with Gilman et al. since Gilman et al. do not have anything to do with audio information. Koyata et al. is a dubbing system only for use in audio applications. With applicants arrangement, a user can take a removable storage medium already having recorded images and the printing and audio enabling software to various different locations where audio can be transferred onto the removable storage medium or, the images can be printed. Applicants believe that claim 3 defines new and unobvious subject matter and should be allowable.

Claims 2, 5, and 9-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilman et al. in view of Koyata et al. and further in view of Anderson et al. (US Pat. No. 6,839,059)

Claim 2 has been cancelled and the remaining claims all depend upon amended claim 3 and should be allowed along with it. Gilman et al. and Koyata et al. have been discussed above.

Applicants agree that Anderson et al. discloses audio clips and corresponding images and storing them together. Nothing in Anderson et al. discloses or suggests providing audio and printing enabling software on the same removable storage medium with digital images. Therefore, applicants believe Anderson et al. should not stand in the way of the allowance of this case.

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilman et al. in view of Koyata et al. as applied to claims 3 and 4 above, and further in view of Hu (US Pat. No. 6,990,293)

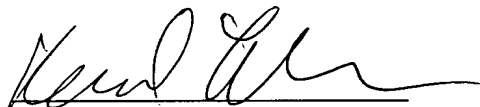
Claim 5 now depends upon amended claim 3 and should be allowed along with it. Gilman et al. and Koyata et al. have been discussed above. Hu discloses an annotation and display apparatus wherein image prints successively displayed and audio messages are recorded on the back surface of the prints. Applicants fail to see how Hu in any way can be combined with any of

the other cited references to provide the subject matter of claim 3. Hu has a print with an audio file on its back surface. There is nothing here that would suggest a removable storage medium having digital images and the audio and printing enabling software of claim 3.

It is believed that these changes now make the claims clear and definite and, if there are any problems with these changes, Applicants' attorney would appreciate a telephone call.

In view of the foregoing, it is believed none of the references, taken singly or in combination, disclose the claimed invention. Accordingly, this application is believed to be in condition for allowance, the notice of which is respectfully requested.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.